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In re Application of
BOTT et al.
Serial No.: 09/762,163
PCT App. No.: PCT/GB99/02425
Int'l Filing Date: 23 July 1999
Priority Date: 04 August 1998
Attorney Docket No.: 4002-006
For: AUTOMATED IMMUNOASSAY
APPARATUS WITH FLEXIBLE PICK-UP ARM

DECISION ON RENEWED
PETITION UNDER
37 CFR 1.137(b)

This is a decision on applicants' Request for Reconsideration of his "LETTER RE: Petition Pursuant to 37 CFR 1.137(b)", filed on 12 August 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 09 March 2001, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants indicating that the oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the 20 or 30 month period, was required.

On 08 July 2002, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant.

On 07 January 2005, applicants responded to the Notification of Abandonment with a petition to revive along with a 3 page executed declaration and surcharge for filing the declaration after the thirty month period. Applicant submitted a petition fee in the amount of \$665.

On 04 March 2005, a decision dismissing the petition was mailed to applicant indicating that applicant paid the incorrect petition fee. Applicant had failed to pay the appropriate petition fee of \$750 (small entity) pursuant to a change in fees effective 08 December 2004.

On 11 March 2005, applicant, by letter, submitted the additional fees required to pay the appropriate petition fee.

On 06 June 2005, a decision dismissing the petition under 37 CFR 1.137(b) was mailed to applicant indicating that declaration submitted on 07 January 2005 is unacceptable as filed. Applicant was advised that one declaration where all inventors have signed or two separate complete declarations in compliance with 37 CFR 1.497 was required.

On 12 August 2005, applicant filed a request for reconsideration along with a request for a one

month extension of time.

DISCUSSION

The executed declaration, submitted on 07 January 2005 is comprised of three pages. It appears that the first page of the declaration was not submitted. The declaration contains duplicate signature pages. Each page is signed by different inventors and combined into one declaration. Thus, the declaration is not properly executed. The declaration is either pieced together from separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration.

Counsel argues that because all four inventors were identified on the declaration, the declaration was properly executed.

Here, the declaration appears to be missing the first page and as such, it does not comply with 37 CFR 1.497(a) and 1.63(b); i.e. the declaration does not identify the specification to which it is directed; the persons making the declaration do not state that they believe that they are the original and first inventors of the subject matter which is claimed and for which a patent is sought. Moreover, applicant has attached two signature pages to what appears to be the second page of the declaration. The declaration as submitted is incomplete and appears to be combination of two declarations. Each inventor must sign a complete declaration.

Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. While the inventive entities are listed on one page, the declaration is incomplete as filed.


What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) have not been met and the declaration is unacceptable as filed.

CONCLUSION

The petition under 37 CFR §1.137(b) is **DISMISSED WITHOUT PREJUDICE**. The application remains abandoned.

The declaration submitted on 07 January 2005 is unacceptable as filed. What is required is one declaration where all inventors have signed or two separate complete declarations in compliance with 37 CFR 1.497. Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 1.497(a) and (b). Extensions of time are available under the time remaining from the 04 March 2005 decision.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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